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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,434	06/09/2000	Dean F. Jerding	A-6594	1996

5642 7590 11/17/2003

SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## NOTICE OF NON-RESPONSIVE AMENDMENT

### *Election/Restrictions*

1. Claims 1-5, 16-21, and 22-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

### *Priority*

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Accordingly, for the purposes of evaluation of prior art, the application filing date shall be the filing date of the instant application or 09 June 2000.

With respect applicant's remarks for a claim to priority to a provisional application, the applicant's remarks are not fully responsive in so far as there is no adequate showing as to how the prior application fulfills the best mode, enablement, and written description requirements of 35 U.S.C. 112 in conjunction with a provisional application. Furthermore, the applicant remarks that the cited documents "are not printed publications that describe the

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claimed aspects of the invention prior to the filing of the instant application (Page 11). Based on the applicant's remarks, it is unclear as to how these documents may provide adequate support under 35 U.S.C. 112 if they even don't describe the claimed aspects of the invention. As previously indicated, the provided documents are provided simply to "further describing aspects of the invention". The reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). Accordingly, it is the examiner's opinion that the priority date of the instant application is that of the filing date or 9 June 2000.

***Requirement for Information***

3. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The applicant's remarks pertaining to the examiner's previous request for information are not fully responsive in light of the priority date of the instant application being that of the filing date of 9 June 2000.
4. An issue of public use or on sale activity has been raised in this application as evidenced by the "Client User Interface Specification for Video-On-Demand Application Development on the Explorer 200™ Digital Home Communications Terminal, revision 1.10 of 8/31/98" document by Shashi Goel which remarks that the claimed invention was "to be deployed for demonstration in the field, in September 1998" (Page 3, Section 1.2). In order for the

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examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required.

The applicant remarks that they “do not believe that there was such a demonstration prior to the effective filing date of the current application (June 11, 1999)”. This statement is viewed as being non-responsive in two ways. First, as the effective filing date of the instant application is 9 June 2000, applicant’s remarks do not adequately address the issue pertaining to the public use of the claimed invention prior to the filing of the instant application.

Second, while the applicant states that they “do not believe” that such a demonstration or public use took place, this is not an adequate showing of fact as to whether or not a public demonstration as suggested by the documentation provided by the application. Accordingly, the examiner requests that the applicant provide a more definitive showing as to the whether or not the claimed invention or certain aspects of the claimed invention were in fact in public use as suggested by the Goel document prior to the filing date of the instant application 9 June 2000. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

5. With respect to the “The System Architecture Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.01r of March 1999” document by Timothy Addington, the applicant is required to provide all non-patent literature, published applications, or patents (U.S. or foreign) that were used to draft the instant application. See 37 CFR 1.105 (a)(1) and specifically section (iv). While the claims of the instant application are not currently directed towards the subject matter of Figures 4A-4M, the material pertaining to the DSM-CC signaling architecture and

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particularly the prior art nature of this documents is still relevant to the instant application in order to obtain a complete record from which a determination of patentability will be made for this or any of the other related co-pending applications including 09/590,488, 09/590,518, 09/590,520, 09/590,521, 09/692,986, 09/692,995, 09/693,115, and 09/693,780. Furthermore, the applicant is entitled to file a continuation claiming the subject matter illustrated in Figures 4A-4M at a later date at which point the prior art status of the aforementioned document was be clearly relevant. Accordingly, the examiner requests that the applicant definitively clarify the prior art nature of this document by stating conclusively on the record as to whether or not this document was or was not made publicly available in conjunction with the disclosure of the document to the Pegasus design team.

### *Conclusion*

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the

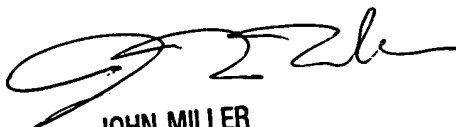
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organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB

November 11, 2003



JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
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